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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,683	02/06/2002	Yuri Gerner	2001-1134.CIP	8779

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EXAMINER

STOCK JR, GORDON J

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/068,683

Applicant(s)

GERNER ET AL.

Examiner

Gordon J Stock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 12-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 11, 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The application does not contain the following drawings: Figures 3-5. The subject matter of this application admits of illustration by a drawing (Figs. 3-5) to facilitate understanding of the invention. Applicant is required to furnish drawings (Figs. 3-5) under 37 CFR 1.81, or amend the specification to exclude Figures 3-5 from the disclosure. No new matter may be introduced in the required drawings.

### *Claim Objections*

2. **Claim 18** is objected to for the following: the phrase, "said end caps," of line 2 of page 27 lacks antecedent basis. Correction is required.
3. **Claim 19** is improperly dependent upon itself. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 2, 3, 4, 9, 14, 15, and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. **Claim 3** recites the limitations "third open channel" and "second end cap." There is insufficient antecedent basis for these limitations in the claim because there is no antecedent basis for a first end cap or a second open channel.
7. **Claim 14** recites the limitations "said protrusions" and "second end cap" and "said third layer." There is insufficient antecedent basis for these limitations in the claim.

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8. **Claim 15** recites the limitation "said layers." There is insufficient antecedent basis for this limitation in the claim.

9. **Claim 18** recites the limitation "said end caps" of line 2 of page 27. There is insufficient antecedent basis for this limitation in the claim.

10. The term "about" in **claim 9** is a relative term that renders the claim indefinite. The term "about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "about" makes the thickness of two wavelengths indefinite.

11. The term "substantially" in **claims 2 and 3** is a relative term that renders the claims indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "substantially" makes the degree of alignment indefinite.

12. The term "substantially" in **claim 4** is a relative term that renders the claim indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "substantially" makes the degree of concentricity indefinite.

13. The term "substantial" in **claim 18** is a relative term that renders the claim indefinite. The term "substantial" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention. The term "substantial" makes the degree of alignment indefinite.

### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. **Claims 18-20** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claim 16** of U.S. Patent Application **09/765497** (Gerner et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because **claims 18-20 and claim 16** of both respective applications is a method of determining sample composition comprising: providing a cell body, providing one or more layers of material lining; attaching one or more end caps including protrusions; transporting

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sample fluid and radiant energy; and receiving and interpreting radiant energy. As for **claims 18 and 20**, the radiant energy blocking portion is a preferred material that may comprise carbon. And as for **claim 19** and the statement “wherein said radiant energy blocking portion is chemically bonded to at least one of said layers,” “even though product-by-process claims are limited by and defined by a process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). So **Claims 18-20 and Claim 16** is not patentably distinct since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As for **claim 19** of **10/068683**, the Examiner has interpreted it as depending on **claim 18**.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 1, 8, and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (5,416,879) as cited by the applicant.

As for **claims 1 and 17**, Liu in an apparatus for measuring light absorption discloses the following: a cell structure having a first elongated tube disposed therein, said first tube including

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a radiant energy blocking portion integral therewith, and a first open channel extending therethrough, such first open channel forming a continuous passageway through said cell structure (Figs. 3 and 5; col. 3, lines 50-67; col. 5; col. 6, lines 1-15).

As for **claim 8**, Liu discloses the radiant energy blocking portion is disposed along a length of first tube (col. 5, lines 9-10).

As for **claim 17** and the statement “wherein said first tube is formed through a single-step extrusion process”, “even though product-by-process claims are limited by and defined by a process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

18. **Claims 1, 8, and 9** are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (5,570,447) as cited by the applicant.

As for **claims 1 and 17**, Liu in an apparatus for measuring light absorption discloses the following: a cell structure having a first elongated tube disposed therein, said first tube including a radiant energy blocking portion integral therewith, and a first open channel extending therethrough, such first open channel forming a continuous passageway through said cell structure (Figs. 1-2; cols. 3-4).

As for **claim 8**, Liu discloses the radiant energy blocking portion is disposed along a length of first tube (Fig. 1).

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As for **claim 9**, Liu discloses the radiant energy blocking portion is spaced from an inner surface of said first tube by at least two wavelengths of radiant energy (col. 3, lines 40-45).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Liu (5,416,879)** as cited by the applicant.

As for **claim 12**, Liu discloses everything as above (see claim 1). However, Liu is silent concerning the radiant energy blocking portion being disposed at respective end surfaces of said first tube. Liu does disclose the tube may be made of the radiant energy blocking material (col. 4, lines 20-21). Therefore, it would be obvious to one skilled in the art at the time the invention was that the radiant energy blocking portion is disposed at respective end surfaces of said first tube, for the first tube may consist of radiant energy blocking material.

21. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Liu (5,416,879)** in view of **Gilby et al. (5,184,192)** as both cited by the applicant.

As for **claim 10**, Liu discloses everything as above (see **claim 1**). However, Liu is silent concerning the radiant energy blocking portion being chemically bonded to said first tube. Gilby in a flow apparatus discloses bonding Teflon AF for a smooth and transparent film layer(col. 3, lines 35-55). It would be obvious to one skilled in the art to have the radiant energy blocking portion bonded to said first tube in order to have a smooth and transparent film layer.



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22. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Liu (5,416,879)** in view of **Dasgupta et al. (6,011,882)** as both cited by the applicant.

As for **claim 5**, Liu discloses everything as above (see claim 1). In addition, Liu discloses that Teflon AF may be used as the radiant energy blocking portion (col. 4, lines 15-20). He is silent concerning perfluorinated copolymers. However, Dasgupta teaches in a chemical sensing technique that Teflon AF is a perfluorinated copolymer (col. 7, lines 1-15). It would be obvious to one skilled in the art at the time that the radiant energy blocking portion comprises perfluorinated copolymers for Teflon AF is a perfluorinated copolymer.

23. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Liu (5,416,879)** in view of **Lahijani (6,177,518)**.

As for **claim 13**, Liu discloses everything as above (see **claim 1**). Liu is silent concerning the radiant blocking portion including carbon. Lahijani in blends of fluoroplastics teaches that carbon may be used in fluoroplastics as a pigment (col. 4, lines 15-20). Therefore, it would be obvious to one skilled in the art at the time the invention was made to have the radiant blocking portion include carbon for coloration.

***Allowable Subject Matter***

24. **Claims 6,7, 11, and 16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claims 2-4, and 15** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims further rewritten in order to overcome the rejections under 35 U.S.C. 112, second paragraph, as stated above.

As to **claim 2**, the prior art of record, taken alone or in combination, fails to disclose or render obvious the particular end cap, in combination with the rest of the limitations of **claims 2, 4, 6, 7, and 11**.

As to **claim 3**, the prior art of record, taken alone or in combination, fails to disclose or render obvious the particular end cap, in combination with the rest of the limitations of **claims 3, 15 and 16**.

#### ***Fax/Telephone Numbers***

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

1) Contain either a statement "DRAFT" or "PROPOSED AMENDMENT" on the fax cover sheet; and

2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

*Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: (703) 308-7722*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (703) 305-4787. The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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January 10, 2003



Frank Font

Supervisory Primary Examiner

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